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PTO IDENTIFIER: Application Number 09/918,721-Conf. #2452
Patent Number 6,909,430 B2

Inventor: Bodin DRESEVIC et al.

MESSAGE TO: US Patent and Trademark Office

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Reply Brief (10 pages)
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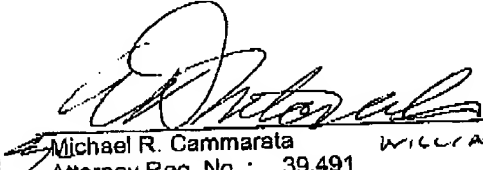
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TRANSMITTAL OF REPLY BRIEF			Docket No. 5486-0165PUS4
In re Application of: Bodin DRESEVIC et al.			
Application No. 11/075,727-Conf. #4188	Filing Date March 10, 2005	Examiner A. A. Caschera	Group Art Unit 2628
Invention: RENDERING INK STROKES OF VARIABLE WIDTH AND ANGLE			
<p style="text-align: center;"><u>TO THE COMMISSIONER OF PATENTS:</u></p> <p>Transmitted herewith is the Reply Brief in this application, with respect to the Appeal Brief filed: <u>August 4, 2008</u></p> <p>The fee for filing this Reply Brief is _____</p> <p><input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity</p> <p><input type="checkbox"/> A petition for extension of time is also enclosed. The fee for the extension of time is _____</p> <p><input type="checkbox"/> A check in the amount of _____ is enclosed.</p> <p><input checked="" type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>02-2448</u> This sheet is submitted in duplicate.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>02-2448</u> This sheet is submitted in duplicate.</p> <p style="text-align: right;">Dated: <u>December 5, 2008</u></p> <p> Michael R. Cammarata Attorney Reg. No. : 39,491 BIRCH, STEWART, KOLASCH & BIRCH, LLP 8110 Gatehouse Road Suite 100 East P.O. Box 747 Falls Church, Virginia 22040-0747 (703) 205-8000</p>			

MRC/WDT/bms

Birch, Stewart, Kolasch & Birch, LLP

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Docket No.: 5486-0165PUS4
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Bodin DRESEVIC et al.

Before the Board of Appeals

Application No.: 11/075,727

Confirmation No.: 4188

Filed: March 15, 2005

Art Unit: 2628

For: RENDERING INK STROKES OF
VARIABLE WIDTH AND ANGLE

Examiner: A. A. Caschera

December 5, 2008

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants submit herewith a Reply Brief in triplicate as required by 37 C.F.R. § 1.192.

This Brief on Appeal responds to the Examiner's Answer dated October 7, 2008.

For clarity, the issues presented in the Appeal Brief filed August 4, 2008, will be repeated, and the Reply to the Examiner's Answer will correspond structurally to the arguments section in the Appeal Brief.

Birch, Stewart, Kolasch & Birch, LLP

MRC/WDT/bms

Application No.: 11/075,727

Docket No.: 5486-0165PUS4

I. ISSUE ON APPEAL

Claims 1, 4-9 and 13-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Eller, U.S. Patent No. 5,287,417.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Eller in view of Bi, U.S. Patent No. 6,924,790.

Claims 10 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eller in view of Silverbrook, U.S. Patent No. 6,965,454.

Claims 18-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eller in view of Lucas, U.S. Patent No. 6,201,528.

Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Eller, Silverbrook and further in view of Lucas.

Claims 1, 9, 16 and 17 stand rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 2-4 of U.S. Patent No. 6,909,430 in view of Eller.

The rejections of the claims 1, 3-10 and 12-22, as recited above, are being appealed.

II. NEW POINTS OF ARGUMENT RAISED BY THE EXAMINER'S ANSWER

Appellants are providing this Reply Brief to respond to new points of argument raised in the Examiner's Answer. Appellants do not disagree with paragraphs (1) - (8) of the Examiner's Answer. In fact, Appellants respectfully thank the Examiner for bringing to the Appellants attention a typographical mistake when noting the fourth grounds of rejection to be reviewed on

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Appeal, specifically the fourth grounds should recite claims 18-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eller in view of Lucas, U.S. Patent No. 6,201,528.

The specific new points of argument that are raised in paragraphs (9) and (10) to which the Appellants disagree are as follows:

1. The Examiner substantially reproduces the text found within the Final Rejection again for arguments in paragraph (9). However, following a good faith review of the context the Examiner's Answer as compared with the Final Rejection; it is reasonably believed that the position taken by the Examiner in paragraph (9) is to support his assertions made by paragraph (10). The Examiner apparently believed it was necessary to reproduce substantially the entirety of the Final Rejection (as set forth in paragraph (9)) to support the assertions made in paragraph (10).

If the intent in doing so was to create a record for the assertions and positions made in paragraph (9), and then link those assertions and positions to the conclusions made in paragraph (10). The Examiner has apparently made a circumstantial conclusion, one not based on the proper factual teachings or legal elements to support a *prima facie* rejection.

Insofar as the Appellants are able to glean new information found within paragraph (9) it appears that the Examiner has reorganized certain sections relating to the dependent claims, but it is not clear from the content of paragraph (9) whether there are substantially any new arguments presented by the Examiner. The Appellants respectfully preserve their right to further supplement the Reply as it pertains to at least paragraph (9).

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Summary of the Examiner's Position in Paragraph (9) and Appellants' Reply thereto

The Examiner asserts that Eller applied under 35 U.S.C. § 102(b), clearly anticipates Appellants' claimed invention. However, the record of this application, including the lengthy arguments asserted by the Examiner supports the converse. That is to say, Eller fails to anticipate Appellants' claimed invention, and the Examiner failed to meet the burden of a *prima facie* case of anticipation. In fact, *the Examiner found it necessary to make no fewer than four interpretive leaps when construing a basis of anticipation with Eller, in view of Appellants' claimed invention, with regards to claims 1 and 9.*

Furthermore, the Examiner has proceeded to support these four interpretive leaps by asserting alleged functional equivalents and inherent similarities between the claimed elements and the disclosure that Eller as a whole provides.

To Anticipate a Claim, the Reference Must Teach Every Element of the Claim

Pursuant to a *prima facie* of anticipation under 35 U.S.C. § 102(b) the Examiner must rigorously determine that "[a] claim is anticipated only if each and every element as set forth in the claim as found, either expressly or inherently described, in a single prior art reference." MPEP 2131, citing Verdegaal Bros. v. Union Oil Co. of California (Fed. Cir. 1987). In addition, when basing a rejection under a single reference § 102, *only that one reference should be used in making a rejection under 35 U.S.C. § 102.*

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However, to explain the meaning of a term used in the primary reference, extra references or other evidence should be used to show meaning of a term used in the primary reference. Furthermore, to show that a characteristic not disclosed in the reference is inherent, an extra reference or evidence can be used to show an inherent characteristic of a thing taught by the primary reference. MPEP 2131.01 II and III.

It is well settled, that explanation of the meaning of a term used in the primary reference may be accomplished with extrinsic evidence. However, extrinsic evidence *may not be used to expand the meaning of terms and phrases used in the reference as anticipatory of the claimed subject matter.* In re Baxter Travenol Labs (Fed. Cir. 1991).

It is also well settled "to serve as an anticipation when the reference is silent about the asserted inherent characteristic, such a gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. USA v. Monsanto Co. (Fed. Cir. 1991).

Accordingly, Appellants respectfully assert that the Examiner did not render a proper construction of anticipation with Eller. The Examiner appears to have either improperly applied extrinsic evidence to expand the meaning of the terms and phrases used in Eller or, absent some extrinsic basis, Eller clearly suffers from several shortcomings that result in at least a gap in the asserted teaching. In which case the Examiner has impermissibly applied hindsight reasoning. Accordingly, the Examiner's tenuous use of at least Eller has failed to make a *prima facie* case of

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anticipation with regards to claims 1, 4-9 and 13-17 under 35 U.S.C. § 102(b) as being anticipated.

Furthermore, Appellants respectfully assert that the claimed invention is patentably distinct from any claim of anticipation or obviousness based at least in part upon Eller, since Eller is not only patentably distinct over Appellants' claimed invention, but also appears to teach away from several of the salient aspects, which Appellants' have made numerous attempts to raise with the Examiner.

The Examiner's tenuous construction of Eller improperly attempts to redirect the *clear teaching away with no fewer than four interpretive leaps*.

Accordingly, for all of the above bases, Appellants believes that Eller fails to anticipate Appellants' claimed invention.

With regards to the operation of Appellants claimed invention, Appellants believe that the claimed invention, whereby a dynamic representation is display of the digital ink stroke as the ink stroke proceeds' from a first pen tip instance to a second pen tip instance is not found within the Eller reference.

Specifically, Eller recites for each data point input by the user, the recognizer maps the data point to a normalized data point then transforms the normalized data point into a transform data point, and then determines when the transform data point is a shape-defining data point or

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an interior-defining data point. Again, this is a clear indication that the determination within Eller does not function in a dynamic manner as set forth in Appellants' claimed invention.

Appellants also respectively assert that there is a great deal of activity by the Eller reference that must happen well before the Eller reference even begins to select a representation of the graphic object that corresponds to the determined attributes, and finally displays the selected representation on the electronic tablet. See, for example, column 2, lines 15-22. Clearly a distinct temporal break occurs since the graphic object must be thoroughly recognized pursuant to the process summarized in column 2 of the Eller patent. See column 2, lines 1-22.

With Eller, the graphic object is made up of a plurality of data points and for each data point input by a user the recognizer maps the data point to a normalized data point then transforms the normalized data point into a transformed data point, and then determines whether the transformed data point is a shape-defining data point or an interior defining data point. Based on the coordinates of the transformed data points and the coordinates of the data points input by the user, the recognizer then determines the attributes. Clearly all of this must happen before an attribute of the graphic object are determined. Such objects may include whether a line style and a transparent fill pattern are to be implemented. See, for example, column 2, lines 16-17.

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Eller is not Established under 35 USC § 102(b)

Furthermore in the Examiner's Answer at paragraph (10) Appellants respectfully assert that contrary to the Examiner's statement, Eller has not been established to explicitly disclose the claimed system. See, for example the admitted interpretive leaps in the Examiner's Answer within paragraph (9). Appellants firmly believe that Eller fails to anticipate or disclose the instant claimed invention. Furthermore, Appellants respectfully indicate that the Examiner may have impermissibly applied the elements of Eller out of the clear context that the Eller reference as a whole would teach.

In addition to the assertion made previously, it appears that from the Examiner's Answer at page 18, line 7, that the Examiner was impermissibly applying a system element or elements to claims directed to a method. As such, and in addition to the assertions made previously hereto, Appellants respectfully assert that the element by element matching by the Examiner, in addition to the clear shortcomings previously indicated, also suffer from an improper construction and cannot support a *prima facie* rejection. As such, Appellants respectfully assert the conclusions drawn by the Examiner, as supported by the Eller reference, are factually inapposite to the Appellants' claimed invention, and legally improper to support a *prima facie* rejection.

Accordingly, Appellants respectfully maintain:

- A.) Claims 1, 4-9 and 13-17 are patentable over Eller;

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- B.) Claim 3 is patentably distinct over Eller in view of Buy;
- C.) Claims 10 and 12 are patentably distinct over Eller in view of Silverbrook;
- D.) Claims 18-21 are patentably distinguishable over Eller in view of Lucas;
- E.) Claim 22 is patentably distinguishable over Eller, Silverbrook, and further in view of Lucas; and
- F.) Claims 1, 9, 16 and 17 are patentably distinguishable over U.S. Patent No. 6,909,430 in view of Eller.

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III. CONCLUSION

Appellants relies on the arguments set forth in Appellants' Appeal Brief for those issues the Examiner has merely repeated those assertions set forth in his claim rejections. For all of the reasons set forth above, each of the rejections in the Examiner's Answer dated October 7, 2008, is improper. It is therefore respectfully requested that the Examiner be reversed on all grounds.

Dated: December 5, 2008

Respectfully submitted,

By 

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